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| 10/729,043 | 12/05/2003 | Scott Goldthwaite | WS-104 | 9327 |
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| AKC PATENTS 215 GROVE ST. NEWTON, MA 02466 | | | EXAMINER VYAS, ABHISHEK | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/729,043

Applicant(s)

GOLDTHWAITE ET AL.

Examiner

ABHISHEK VYAS

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendments and remarks filed on 01/27/2009.
2. Claims 1 and 23 have been amended.
3. Claims 14, 24, 37 have been canceled.
4. Claims 1-45 are currently pending and have been examined.
5. Claims 1-45 are rejected.
6. This is a FINAL rejection.

Response to Arguments

7. Applicant's arguments regarding the 35 USC 103 rejections have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show, teach or suggest certain features of applicant's invention, such as "a communication device that comprises a subscriber identification module (SIM) card slot and that said payment card reader is electrically connected to the SIM card slot", the examiner respectfully disagrees. The feature recited in claim 1 and 23 was previously rejected under Gobburu, Young and Jacobson. Jacobson in paragraph 0015 clearly teaches an electrical connection to connect a MMC (Multimedia card; which can function as a smart card and store payment information. Thus in this embodiment a reader housing having the pins to read a MMC containing payment information is broadly interpreted as a payment card reader). Jacobson then teaches *"For electrically connecting the MMC and the SIM with the electronic device.....wherein the pads of the MMC and the SIM make contact with the respective set of contacts"*. It is obvious that a dual card reader will be electrically connected in a way where the occupants of the reader (the MMC and SIM cards) can communicate with each other. Without an electrical connection to connect both cards it would not be useful or practical to have such a dual reader configuration. A payment card reader is broadly interpreted as a smart card reader,

since a smart card can also contain payment information as taught by Gobburu (see at least column 17 lines 55-57, 61-67; column 18, lines 1-10, 17-37, 39-50). The examiner also notes that the recess as argued is not pertinent. Whether it is for a battery pack or a SIM card is not patentably distinguishing as long as the limitation of the claim (electrically connected slots) is taught by the prior art. The prior art teaches that both SIM and the payment card reader are electrically connected, therefore the prior art has met the limitations of the amended claims.

8. In response to applicant's argument that Young does not teach the limitation of "storing the digital good onto the payment card", the examiner respectfully disagrees. The claim is rejected under a combination of Gobburu, Young and Taylor. Gobburu in column 9, lines 9-14, 20-26; column 12, lines 45-51; column 14, lines 11-21, Figure 3, 10A and related text, Discloses storage of an airline ticket boarding pass bar-code(broadly interpreted as a digital good) on the communication device (see column 23, 8-11). It is obvious that a digital good when purchased via a communication device will be stored, delivered or downloaded to the device's memory (internal or external) or SIM card depending on the design preference of the manufacturer (see Gobburu column 25, lines 27-30, 34-36). It is old and well-known that a SIM (also interpreted as a payment smart card) is used to store electronic credits (goods) upon transacting or receiving or sending payments. The examiner cites 6,142,369 Jonstromer (column 2, lines 25-35; column 5, lines 7-20, 45-55) in support of this rational. The reference is not relied upon in the rejection, it is simply provided to support the examiner's assertion. Therefore at this time the request for allowance is respectfully declined.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 1-23**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Gobburu et al. United States Patent No.: 6,736,322 B2, in view of Young et al. United States Patent Application Publication No.: US 2002/0065774 A1 and Taylor et al (herein after Taylor) United States Patent Application Publication No.: 2002/0025796 (filed 05/08/2001) and in further view of Jacobson United States Patent Application Publication No.: 2003/0004876

11. **As per claim 1 and 23**, Gobburu discloses the limitation of:

- route said authorization and said payment card identification and security information to the authentication server, and wherein said authentication server further routes said authorization and payment card identification and security information to said payment server and from said payment server to a financial institution, (see at least Gobburu column 18, lines 43-50).
- wherein said communication device receives said first message from said authentication server, display said first message to said customer, request and receive authorization for payment for said purchase order with said payment card from said customer, retrieve said payment card identification information, request and receive payment card security information from said customer (see at least Gobburu column 17 lines 55-57, 61-67; column 18, lines 1-10, 17-37, 39-50).

Gobburu does not specifically disclose the following limitations. Young, however, as shown discloses:

- a merchant server receiving a purchase order from said Customer for the purchase of said digital good, and to create a digital order comprising purchase order information; (see at least Young paragraph 0008, 0009, 0018).
- a payment server receiving said digital order from said merchant server and to further route said digital order; (see at least Young paragraphs 0009, 0011, 0037 and 0060).

- an authentication server receiving said digital order from said payment server, format said digital order into a first message and further route said first message; (see at least Young paragraphs 0008, 0060)
- wherein said financial institution is asked to execute said payment and to send a payment confirmation through said payment server to said merchant server and to said authentication server (see at least Young paragraphs 0021, 0039-0040, 0057, 0060, 0062).
- a fulfillment server receiving said payment confirmation from said payment server and transmit said digital good via said authentication server to said communication device, wherein said communication device stores said digital good onto said payment card (see at least Young paragraphs 0009, 0010, 0011, 0065, 0070).

Gobburu discloses a built in smart card reader that can read identification, electronic purse information (see at least Gobburu column 17, lines 65-67 continued to column 18 lines 1-9). Taylor, however, specifically teaches the following limitation:

- a communication device comprising a payment card reader wherein said payment card reader receives a payment card and read payment card identification information stored in said payment card, (see at least Taylor paragraphs 0008-0009, 0017-0021, 0025-00028)

As per further limitations of claims 1 and 23, Gobburu/Young disclose a smart card, a SIM, a charge card and a smart card reader. Gobburu/Young do not specifically disclose the following limitation. Jacobson, however, teaches the limitation below:

- Wherein said communication device comprises a subscriber identification module (SIM) card slot and said payment card module is electrically connected to said SIM card slot (see Jacobson paragraph 0015, 20).

It would have been obvious to one of ordinary skill in the art at the time of the invention to specifically include an electrical connection to the SIM card. One would be motivated to do so to create a faster

communication link between the mobile device and the external read/write interface attached to it. Further, it is well known in the art for card module to have electrical connections from the card slot to the mobile unit it is attached to. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the system and method of Gobburu with the electronic transaction method and system of Young to offer a convenient method to purchase goods or services remotely or in a retail environment with more security and control over the transaction. One would be motivated to do so as it would help in the transaction becoming efficient and fraud-proof. Both references allow users to choose from a plurality of payment methods. The references discuss the use of various electronic hardware devices in conjunction with communication networks, interacting fully with a user to accomplish a transaction. Further, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the system of Gobburu, Young and Taylor to include a remote retail environment as aforementioned in the references above. One would be motivated to do so to provide consumers more exposure to products that may not be available in a face-to-face store. It would also allow the consumer to purchase a good or service whenever they deem appropriate, with the benefit of paying through a mobile device using a communications network. One would be motivated to do so to increase sales and profits for a merchant by attracting the remote, mobile shoppers who cannot easily access conventional retail stores. It would have further been obvious to one of ordinary skill in the art at the time of the invention to have specifically modified a smart card reader with a magnetic card reader as clearly taught by Taylor (Taylor paragraph 0018). Taylor also teaches a communication network such as a cell network and another network such as a blue-tooth operating in conjunction (see Taylor paragraphs 0025-0028). It should also be obvious to one of ordinary skill in the art a merchant server will have to receive an order from a customer who sends an order. If a customer sends an order and the merchant doesn't receive it, there is no useful and tangible result of the method.

12. **As per claims 2 and 25**, Gobburu discloses the following limitation:

- communication device comprises a wireless communication device (see at least Gobburu column 9, lines 51-54, lines 58-64).

13. **As per claims 3 and 26**, Gobburu teaches the following limitations:

- communication device comprises a wired communication device (see Gobburu column 9, lines 47-54).

14. **As per claims 4 and 27**, Gobburu teaches a merchant server, database, mobile device and a service provider all connected through a communications network. Gobburu does not disclose the limitations below. Young, however, discloses the limitations as follows:

- merchant server, said payment server, said authentication server, said fulfillment server and said communication device send and receive messages among each other via a first network (see at least Young paragraphs 009, 0017-0019).

It would have been obvious to one of ordinary skill in the art at the time of the invention to expand the system of Gobburu to include various functionally similar units to communicate together. One would be motivated to do so to create a streamlined and efficient purchase transaction for the benefit of the consumer and seller. There would be no useful result if the functional units of a transaction system do not communicate with each other. Server communication is ubiquitous in the art.

15. **As per claims 5 and 28**, Gobburu discloses a SMS capable mobile device. Gobburu also discloses the limitations below:

- merchant server, said payment server, said authentication server, and said fulfillment server send and receive messages among each other via a first network and said wireless communication device sends and receives messages to said authentication server via a second network and wherein said second network comprises a wireless network (see at least Gobburu column 9 lines 40-47, lines 58-64).

16. **As per claims 6 and 29**, Gobburu discloses the following limitation:

- wireless communication device is selected from a group consisting of a mobile phone, a personal digital assistant, a pager, a wireless laptop computer, a personal computer, a television remote control, programmable versions thereof and combinations thereof (see Gobburu column 10, lines 28-30, lines 55-60).

17. As per claims 7 and 30, Gobburu discloses the following:

- wireless network is selected from a group consisting of a wireless wide area network (WWAN), a wireless local area network (WLAN), a personal area network (PAN) and a private communication network (see Gobburu column 9, lines 51-54, lines 58-64).

18. As per claims 8 and 31, Gobburu discloses:

- wireless wide area network (WWAN) is selected from a group consisting of a Global System for Mobile Communications (GSM), General Packet Radio Service (GPRS), a Code Division Multiple Access (CDMA), CDMA 2000, and wideband CDMA (WCDMA) (see Gobburu column 10, lines 50-54).

19. As per claims 9 and 32, Gobburu discloses the following limitations:

- wired communication device comprises a telephone and said first network comprises a telecommunications network (see Gobburu column 9, lines 58-61; column 11, lines 17-20, lines 27-35).

20. As per claims 10 and 33, Gobburu discloses:

- wired communication device comprises a computer and said first network comprises the Internet (see at least Gobburu column 9, lines 51-54, lines 58-64).

21. As per claim 11 and 34, Gobburu discloses:

- payment card comprises a smart card selected from a group consisting of a full size smart card, a contact less smart card, a SIM smart card, a USIM smart card, a credit card, a debit card, a stored-value card, a coupon card, a reward card, an electronic cash card, a loyalty card, an identification card and combinations thereof (see at least Gobburu column 18, lines 2-3 and lines 28-30).

22. As per claims 15 and 38, Gobburu discloses:

- payment card information is selected from a group consisting of cardholder identification information, card identification information, authentication information, card issuer information, and financial institution information (see at least Gobburu column 9, lines 1-3, lines 28-31).

23. **As per claims 13 and 36**, Gobburu discloses the following:

- merchant server receives said purchase order by said customer via a route selected from a group consisting of the Internet, telephone connection, mail order form, fax, e-mail, voice recognition system, shot message service, interactive voice recording (IVR), and face-to-face communication with the customer (see Gobburu column 11, lines 25-27; column 24, lines 23-29).

24. **As per claims 16 and 39**, Gobburu discloses the following limitations:

- digital good is selected from a group consisting of electronic cash, electronic tickets, electronic coupons, loyalty points, credits for pre-paid mobile airtime, credits for pre-paid utilities, electronic gift certificates, digital rights managements(DRM) certificates, electronic transit tokens, music, software, movies, and books (see at least Gobburu column 20, lines 46-53).

25. **As per claims 17 and 40**, Gobburu discloses a merchant server and a bank server. Gobburu does not specifically teach the limitation below. Young, however, teaches the limitation below:

- merchant server and said fulfillment server comprise one entity (see Young paragraphs 0009, 0011).

It would have been obvious to one of ordinary skill in the art at the time of the invention to expand the system of Gobburu to facilitate a single merchant and fulfillment server to reduce overhead and operating costs as well as potential bottlenecks in operations.

26. **As per claims 18 and 41**, Gobburu discloses the following:

- customer places said purchase order to said merchant server via said communication device (see at least Gobburu column 18, lines 39-43).

27. **As per claims 19 and 42**, Gobburu discloses the limitation as follows:

- communication device further comprises a shopping application and wherein said customer utilizes said shopping application, to select said digital good, to place said purchase order, to authorize, authenticate and pay with said payment card, and to store

said digital good onto said payment card (see at least Gobburu column 17, lines 23-30; column 25, lines 22-25, lines 34-37).

28. **As per claims 22 and 45**, Gobburu discloses the limitation as follows:

- First message comprises a format selected from a group consisting of Short Message Service (SMS), General Packet Radio Service (GPRS), Transmission Control Protocol/Internet Protocol (TCP/IP), User Datagram Protocol (UDP), Simple Mail Transmission Protocol (SMTP), Simple Network Management Protocol (SNMP), and proprietary message formats (see Gobburu column 10, lines 50-54).

29. **Claims 12, 20, 35 and 43** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gobburu et al. , Young et al. , Taylor and Jacobson, as applicable to claims 1 and 23 above and in further view of Jacobson United States Patent Application Publication No.: US 2003/0004876 A1

30. **As per claims 12 and 35**, Gobburu/Young disclose a smart card, a charge card and a smart card reader. Gobburu/Young do not specifically disclose a magnetic stripe card. Jacobson, however, teaches the limitation below:

- Payment card comprises a magnetic stripe card (see at least Jacobson paragraph 0020, 0023, 0103, and 0105).

It would have been obvious to one of ordinary skill in the art at the time of the invention to expand the system of Gobburu/Young to include a magnetic stripe card. One would be motivated to do so to provide user an option to pay with a magnetic strip based card.

31. **As per claims 20 and 43**, Gobburu/Young disclose a smart card and a smart card reader. Gobburu/Young do not disclose the limitations below. Taylor, however, teaches the limitations below:

- Payment card reader reads and writes information from and to said payment card (see at least Taylor paragraphs 0018-0020, 0025).

It would have been obvious to one of ordinary skill in the art at the time of the invention to expand the system of Gobburu/Young to specifically include a payment card reader and write module.

One would be motivated to do so to improve efficiency and add the capability or functionality for a mobile device to read magnetic as well as smart card (payment and identification information; see Taylor paragraphs 0008-0009, 0025, 0026)

32. **Claims 21, 24, 44** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gobburu et al. , Young et al. , Taylor and Jacobson as applicable to claims 1 and 23 above and in further view of Kelly et al United States Patent No.: 5,816,918

33. **As per claims 21 and 44**, Gobburu/Young disclose a mobile communication device and a SIM card capable of executing instructions to interact with a merchant server. Gobburu/Young do not disclose the following limitations. Kelly, however, teaches the limitation as follows:

- communication device further comprises a digital good generation application and wherein said digital good generation application receives a digital receipt for said digital good and generates said digital good (see at least Kelly column 15, lines 32-34, lines 37-42).

It would have been obvious to one of ordinary skill in the art at the time of the invention to expand the system of Gobburu/Young to include purchase of digital goods. One would be motivated to do so to expand the realm of product exposure to the customer. By providing customers with digital as well as non-digital goods, overall sales for the merchant may increase.

Examiner would like to point out that the Supreme Court in KSR International Co. v. Teleflex Inc. described seven rationales to support rejections under 35 U.S.C. 103: Combining prior art elements according to known methods to yield predictable results; Simple substitution of one known element for another to obtain predictable results; Use of known technique to improve similar devices (methods, or products) in the same way;

- Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- "Obvious to try" -choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

- Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; and
- Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

34. A digital good is an obvious substitution for any goods and services purchased at a mobile point of sale (using a mobile device) see [Gobburu (column 17, lines 55-60)]. A digital purchase or download is interpreted as a predictably obvious variation in the same field of mobile ordering and payment authorization.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abhishek Vyas whose telephone number is 571-270-1836. The examiner can normally be reached on 7:30am-5:00pm EST Mon-Thur, ALT Friday OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A. V.
Examiner, Art Unit 3691

/Alexander Kalinowski/

Supervisory Patent Examiner, Art Unit 3691